

REMARKS

Claims 1 to 16 are pending in the present application. Claims 1, 3, 6, 7, 9, 11, 13 and 15 have been amended. No new matter has been added. Reconsideration, in view of the following remarks, is requested.

On page 2 of the Office Action, certain claims not explicitly identified by the Office Action were rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, the Office Action asserts on page 2 that the disclosure lacks clear written description for the recited features of “an SMS message and/or email about the one of the predefined operating states is sent to a predefined distribution group”.

With respect to the claims being rejected under the first paragraph of 35 U.S.C. § 112, the rejection is not understood since the specification as originally filed recites these features verbatim in claim 1. Additionally, the originally-filed specification states, for example, on page 2, lines 5 to 9, that:

According to the present invention, predefined operating states are allocated on an individual basis by means of a converter, to the effect that, if these operating states are present, an SMS message and/or an e-mail about the respective operating state is sent to a predefined distribution group.

Hence, the Specification as originally filed provides an adequate written description for the subject matter claimed. That is, the Specification as filed conveys with reasonable clarity to those skilled in the art that, as of at least the filing date of the present application, the Applicant was in possession of the subject matter claimed, which is all that is required to satisfy the written description requirement under 35 U.S.C. § 112, first paragraph. Accordingly, the rejection is not understood and is plainly obviated by the foregoing.

Moreover, the Examiner also has the initial burden of presenting “evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.” (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). The Manual of Patent Examining Procedure also provides that if an examiner rejects a claim based on the lack of a written description, the examiner should provide “reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application.” (See id.). However, the Examiner has clearly failed to satisfy these requirements.

Accordingly, in view of all of the foregoing, it is respectfully requested that the rejection under 35 U.S.C. § 112, first paragraph be withdrawn.

Claims 1, 3, 6, 7, 9, 11, 13 and 15 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite with respect to the term “and/or” recited in the claims. In this regard, claim 1, 3, 6, 7, 9, 11, 13 and 15 have been rewritten to remove the term “and/or”. It is therefore respectfully submitted that claims 1, 3, 6, 7, 9, 11, 13 and 15, as presented, are clear and definite, and therefore withdrawal of the indefiniteness rejections is respectfully requested.

Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite with respect to the recited feature “an SMS message and/or email about the one of the predefined operating states is sent to a predefined distribution group”. In particular, the Office Action asserts on page 3 that the recited feature is vague and indefinite, and that the relationship among a SMS message, an email message, predefined operating states and a distribution group is unclear. Although Applicant does not necessarily agree with the merits of this objection, to facilitate matters claim 1 has been amended to recite “a notification about which of the predefined operating states is present is sent to a predefined distribution group, the notification including at least one of an SMS message and an email.” Accordingly, it is clear that what is sent to the predefined distribution group is a notification about which of the predefined operating states is present, and that the notification can include an SMS message, an e-mail, or both an SMS message and an e-mail. It is therefore respectfully submitted that claim 1, as presented, is clear and definite, and therefore the rejection should be withdrawn.

Claims 1, 9, 11, 13 and 15 were asserted to be vague and indefinite as to “what is the relationship associated between a converter and a predefined operating state”. In this regard, it is respectfully submitted that the rejection is not understood since the claims recite “a converter which associates predefined operating states ... to respective at least one of messages and alarms ...”. That is, the converter itself is not associated with a predefined operating state, as suggested on page 3 of the Office Action, but rather the converter performs the association between the predefined operating states and the messages/alarms. Indeed, such an association by the converter is provided “so that, if one of the predefined operating states is present, a notification about the one of the predefined operating states is sent to a predefined distribution group ...”. Claim 1, as presented. Accordingly, it is respectfully submitted that claims 1, 9, 11, 13 and 15, as presented, are clear and definite, and therefore the rejection should be withdrawn.

Claim 1 was asserted to be vague and indefinite with respect to the recited feature of "information identifying particular information to be included in the SMS message and/or email messages". Although Applicant does not necessarily agree with the merits of this objection, to facilitate matters claim 1 has been amended to recite "information to be included in the notification", and is believed to be self-explanatory. Accordingly, claim 1, as presented, is clear and definite, and withdrawal of the indefiniteness rejections is respectfully requested.

CONCLUSION

In light of the foregoing, Applicant respectfully submits that all of the pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited. The Examiner is invited to contact Applicant's representative, Michelle Carniaux at 212-908-6036 for any issues still outstanding in this application.

Respectfully submitted,

KENYON & KENYON LLP

Dated: 10 July 2008

By: 

Gerard A. Messina
Reg. No. 35,952

(NY No. 36098)

One Broadway
New York, New York 10004
(212) 425-7200
Customer No. 26646